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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,060	09/29/2003	Stephen Fitzgerald	CE-COMP-04.US	4727
55678	7590	02/07/2006	EXAMINER	
MILTON, GELLER, LLP 700 - 225 METCALFE STREET OTTAWA, ON K2P-1P9 CANADA			GRAHAM, MARK S	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,060

Applicant(s)

FITZGERALD ET AL.

Examiner

Mark S. Graham

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-52 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 31, 32, 37-39, 42/(31, 32, 37-39), 43/42/(31,32,37-39), 44/42/(31,32,37-39), 45/52/(31,32,37-39) is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 14-30, 33-36, 40, 41, 42/(36,40), 43/42/(36,40), 44/42/(36,40), 45/42/(36,40), 46-52.

Applicant's election with traverse of the Fig. 6 embodiment in the reply filed on 8/31/05 is again acknowledged. The traversal is on the ground(s) that the different embodiments represent a single invention. This is not found persuasive because the applicants have not admitted for the record that the various embodiments are obvious variants of one another.

The requirement is still deemed proper and is therefore made FINAL.

Claims 14-30, 33-36, 40, 41, 42/(36, 40), 43/42/(36,40), 44/42/(36,40), 45/42/(36,40), and 46-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/31/05. Applicant's comments regarding claims 21, 41, 42/41 have been noted. However, no support is found for the 5% limitation with regard to the Fig. 6 embodiment.

With regard to amended claim 14 and the claims dependent thereon, the amendment thereto pertains only to the Fig. 10 embodiment with the internal stiffener 18 and therefore the claim and the claims dependent thereon are no longer generic.

Concerning claim 40 and the claims dependent thereon, the only particularly disclosed thickness pertains solely to embodiments other than that depicted in Fig. 6 which was elected by applicant and pertains solely to an embodiment wherein fiber type/angle change vary the radial stiffness. The only embodiments disclosed wherein the thickness of the barrel is varied are those with a stiffener 18 and apparently a variation of the Fig. 6 embodiment which is not shown. Therefore these claims are properly grouped with the claims of the non-elected embodiments.

The amendment filed 12/23/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall

introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The new disclosure with regard to Fig. 6 in paragraph 61 lacks basis in the original disclosure. The thickness specifically discussed in the original disclosure only pertains to the embodiments having a stiffener 18 or a variation of the Fig. 6 embodiment. The Fig. 6 embodiment does not offer this feature but instead includes a section 20 of the bat which adjusts the stiffness by means of fiber type or angle change.

The thickness limitation of at least 8 1/3% thickness in paragraph 61 is likewise without support in the original disclosure. There is not basis for the thicknesses used by applicant to derive this value.

Also in paragraph 61 the more narrowly focused ranges of the stiffener wall thickness, and the inclusion that the barrel wall thickness is also in these ranges represents subject matter with no support in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fritzke et al. '022 (Fritzke). Note Fritzke's insert as shown in Figs. 14 and 15 which may be bonded to the

inside of the barrel. This insert provides a graduated area of radial thickness in the barrel wall which is greatest at the center portion of the insert.

Concerning claim 31, because Fritzke anticipates the claimed structure the properties of the bat would also be anticipated.

In response to applicant's arguments concerning the claim 31 and 32 rejections Fritzke at paragraph 76 and 77 clearly teaches a composite insert of 4 to 8.5 inches in length graduated such that stiffness is greater in the middle of the insert than at the ends. This is what the claims require. It is suggested that applicant consider paragraph 77 of Fritzke in addition to the drawings for a better appreciation of the location of the insert.

In response to applicant's argument that Fritzke did not appreciate the result claimed by applicant, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Claim 38 is rejected under 35 U.S.C. 102(e) as being anticipated by Vacek. Vacek's insert 112 provided in the center of the barrel contains layers of fibers and thus this portion of the bat barrel has a greater percentage of fibers than do the portions of the barrel at either end of the insert.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vacek. Vacek teaches providing greater stiffness to the bat in the area of the insert. Vacek specifically teaches using a greater percentage of fibers in this area at paragraph 47. However, Vacek also notes that different materials may be used in the insert (paragraph 46) and that the fiber angle may be varied (paragraph 47). Varying the angle of fibers to be greater with regard to the longitudinal axis inherently provides greater radial stiffness and using a stiffer fiber type accomplishes the same result. It would have been obvious to one of ordinary skill in the art to have used either of these known means to provide the extra stiffness in the insert portion desired by Vacek. As the examiner noted in the official notice taken in the previous action different fibers comprise different stiffnesses. Such is now admitted prior art.

Claims 42/(31, 32), 43/42/(31, 32), 44/42/(31, 32), and 45/42/(31, 32) are rejected under 35 U.S.C. 103(a) as being unpatentable over Fritzke. Fritzke discloses the claimed bat with the possible exception of the particularly claimed length of the mid-section. However, absent a showing of unexpected results the exact length of the mid-section would obviously have been up to the ordinarily skilled artisan depending on the particular bat characteristics desired by the batter in the bat. It is clear from Fritzke's drawings that his insert provides the greatest radial stiffness at the sweet spot just as does applicants insert.

Claims 42/(37, 38, 39), 43/42/(37, 38, 39), 44/42/(37, 38, 39), and 45/42/(37, 38, 39) are rejected under 35 U.S.C. 103(a) as being unpatentable over Vacek in view of Fritzke. Vacek discloses the claimed device with the exception of the shorter length of the midsection. Fritzke however discloses that such inserts may be shorter and located at the point of the sweet spot of the bat. While an exact length is not disclosed it is clear from Fritzke's drawings that his insert

Art Unit: 3711

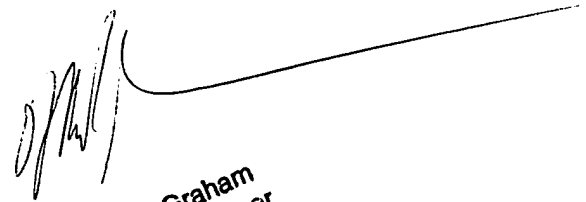
provides the greatest radial stiffness at the sweet spot just as does applicants insert. Absent a showing of unexpected results the exact length of the mid-section would obviously have been up to the ordinarily skilled artisan depending on the particular bat characteristics desired by the batter in the bat.

Regarding applicant's arguments over the length of the Fritzke insert and the length claimed by the applicant in claims 42-45, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). It is noted that applicant has provided no evidence of unexpected results to rebut the presumption of obviousness.

Applicant's arguments with respect to claims 37-39 and the claims dependent thereon have been considered but are moot in view of the new ground(s) of rejection and the reasons expressed above.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 571-272-4410.

MSG
2/2/06



Mark S. Graham
Primary Examiner